

REMARKS/ARGUMENTS

Claims 33-68 are currently active in this case. Claims 69-114 have been cancelled by the current amendment.

In the outstanding office action, claim 56-63, 65, and 109-114 were rejected under 35 USC 102(e) as being anticipated by US patent No. 5,742,668 to Pepe et al.; claims 69-74, 76-79, 81-83, 90-94, and 104-108 were rejected under 35 USC 102(e) as being anticipated by US patent No. 5,659,596 to Dunn; claims 33, 34, 40-47, 54, 55, and 64 were rejected under 35 USC 103(a) as being unpatentable over US patent No. 5,941,956 to Shirakihara et al. in view of US Patent No. 5,159,592 to Perkins; claims 35-38 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Dunn; claim 39 was rejected under 35 USC 103(a) as being unpatentable over Shirakihara and Perkins further in view of Pepe; claims 48-53 were rejected under 35 USC 103(a) as being unpatentable over Shirakihara further in view of Pepe; claims 66-68 were rejected under 35 USC 103(a) as being unpatentable over Pepe in view of Dunn; claim 75 was rejected under 35 USC 103(a) as being unpatentable over Dunn in view of Shirakihara; claim 80 was rejected under 35 USC 103(a) as being unpatentable over Dunn in view of Perkins; and claims 84-89, 95-103 were rejected under 35 USC 103(a) as being unpatentable over Dunn in view of Pepe.

Briefly recapitulating, the present invention (claim 33) is directed to a method for forwarding messages between a host system and a mobile client. Reply messages generated by the mobile client and transmitted to the original message senders via the host system are configured “such that it will appear to the plurality of message senders that the reply messages originated at [a] first address associated with the host system.” This feature is hereinafter referred to as the “transparency feature.” Each of the active independent claims defines this transparency feature.

Pepe

The official action asserts that Pepe teaches a computer system for forwarding messages from a mobile client. In particular, the paragraph bridging pages 2 and 3 of the official office action asserts that Pepe teaches in column 19, lines 41-52 configuring a *received* message to have the transparency feature of the present invention. Applicants respectfully traverse.

Pepe teaches in the subject passage a method for notifying a PDA user that a message (e.g., a voice mail message) has been received. A PCI server 48 *originates* a notification email containing in the *body* of the message, for example, the phone number to call to check the voice mail message. Applicants respectfully submit, however, that Pepe fails to teach or suggest the transparency feature of the present invention for various reasons. First, the notification email is *originated* by the PCI server 48. That is, the PCI server 48 is not configuring a received message to have the transparency feature. Rather, the PCI server is creating a new message to notify a user of the PDA that a new voice mail has been received. Further, the *body* of the notification message includes the identification information of the message sender's address, etc. Pepe does not disclose how the header of the notification message is configured. That is, there is no teaching or suggestion that the email header reflects that the message originated at a first address associated with a host system. Consequently, Pepe does not teach or suggest the transparency feature of the present invention and thus fails to anticipate or render obvious the subject matter defined by the independent claims.

Dunn

Claims 69-74, 76-79, 81-83, 90-94, and 104-108 were rejected as anticipated by Dunn. Each of those claims has been cancelled. Consequently, the 35 USC 102(e) rejection applying Dunn is moot.

Shirakihara

The official action asserts that Shirakihara renders obvious the subject matter defined by claims 33-53. The application that matured into the Shirakihara patent was filed on June 07, 1995. Applicants have submitted herewith a 37 CFR 1.131 declaration by inventor Eggleston which establishes that Applicants reduced to practice the subject matter of claims 33-53 prior to June 07, 1995. Consequently, the Shirakihara patent is not available as 35 USC 102(e) art against Applicants' claims.

In view of the foregoing remarks and the attached 37 CFR 1.131 declaration, no further issues are believed to be remaining. Applicants respectfully request that an interference be declared consistent with Applicants' Suggestion of an Interference.

Respectfully submitted,

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